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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/391,966	09/08/1999	RICHARD J. DITZIK		9391

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EXAMINER

KINCAID, LESTER G

ART UNIT	PAPER NUMBER
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2685

DATE MAILED: 04/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/391,966

Applicant(s)

DITZIK, RICHARD J.

Examiner

Lester G. Kincaid

Art Unit

2685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 54-69 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 54-69 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. **Claims 54-69** are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Specifically, the instant description fails to provide for the “adapting” steps of **claims 54 and 62**. The specification generally provides for a relay function, but fails to mention “adapting” or “configuring” or how any such operation would be performed or why any such operation would be necessary.

Further, to **claim 56**, the instant specification fails to provide for a handset unit that performs the claimed steps to also be used as a PDA.

Further to **claim 58**, the instant specification fails to provide for a handset unit that “is adapted to communication among multiple handset units or earset units”.

Further to **claim 61**, the instant specification fails to provide for a handset unit that “is adapted to hands free speakerphone-like operation”.

Further to **claim 64**, the instant specification fails to provide for a handset unit that includes “data configured to networking functions with one or more handset units”.

Further to **claim 65**, the instant specification fails to provide for a handset unit to configure data for relaying to the internet.

Further to **claim 66**, the instant specification fails to provide for a handset unit that is "adapted to an earset unit".

Further to **claim 68**, the instant specification fails to provide for a handset unit that is "adapted to send and receive e-mail".

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. **Claim 55-61 and 63-69** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to **claim 55**, it is not clear where the "communication means" is intended, that is the terminology "to and from an external wide area communication network" fails to reasonably convey the positioning, or metes and bounds, of the "communication means".

Further to **claims 55-61 and 63-69**, it is not clear whether the intention of the claims is to recite another step of the method or merely modifies the handset of the preamble. The examiner suggests the use of active steps.

Further to **claim 61**, the phrase "speakerphone-like operation" renders the claim indefinite, as it is not clear what differences exist between 'actual speakerphone operation and the operation of the claimed invention.

Further to **claim 64**, the phrase "data configured to networking functions with one or more handset units" is unclear.

Claim Objections

5. **Claims 54 and 62** are objected to because of the following informalities: the claims each recite a method comprising three steps, however each contain four letters - assumably denoting steps. Further, the claims should use a conjunction such as --and-- between steps b and c. Appropriate correction is required.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. **Claims 54-69** are rejected under 35 U.S.C. 102(b) as being anticipated by
Graham et al. (U.S. Patent 5,351,270).

Graham et al. disclose the method of transmission between a (one of multiple) handset (13), a portable base (10) and a network (14), wherein the communication is implemented with conventional digital techniques. See col. 2, lines 7-59.

8. **Claims 54-69** are rejected under 35 U.S.C. 102(e) as being anticipated by Gattey et al. (U.S. Patent 5,553,312).

As to **claim 54**, Gattey et al. disclose a method for handset unit (headset / data entry means, see col. 3, lines 37-67) comprising the steps of:

transmitting and receiving to/from a portable base (12), see Figs. 1 & 4, col. 3, lines 15-35, and col. 4, lines 35-53; and

adapting the data for relay to/from an external wide area network (14), see col. 3, lines 36-45; the data including computer formatted data for bi-directional communication, (see col. 4, lines 54-67).

As to **claims 55 and 58**, Gattey et al. inherently provide for a plurality of such units and therefore meet the broad claims of further communication means and the ability to communicate among multiple handsets or earsets.

As to **claims 56-57, and 59-61**, the claims merely amount to "intended uses" and fail to add patentable limitations.

Claims 62-69, similarly read on Gattey et al.

Response to Arguments

9. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lester G. Kincaid whose telephone number is (703) 306-3016. The examiner can normally be reached on Monday through Friday from 7:30 a.m. to 4:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Urban, can be reached at (703) 305-4385.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 2600 Customer Service Office at (703) 306-0377.

Any response to this final action should be mailed to:

Box AF

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 872-9314 (TC 2600 only)
(for formal communications; please mark "EXPEDITED PROCEDURE")
(for informal or draft communications, please label "PROPOSED" or
"DRAFT" and mark "PLEASE DELIVER TO EXAMINER")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

LGK
March 23, 2003



**LESTER G. KINCAID
PRIMARY EXAMINER**